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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,516	10/15/2001	Hwai-Tay Lin	CFP-1489	5040

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EXAMINER

DURAND, PAUL R

ART UNIT PAPER NUMBER

3721

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,516

Applicant(s)

LIN, HWAI-TAY

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,9-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,9-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/8/03 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juilfs (US 2,983,922) in view of Golsch (US 4,932,480).

In regard to claims 1 and 5, Juilfs discloses the invention substantially as claimed including a cylinder 27, driving element 37, bumper 31, located in a chamber 27, between a piston 39 and end wall (no number given), comprised of a first section that is relieved around it's periphery, a second section of a larger cross sectional diameter against the end wall, the first section forming an annular gap between the inner wall of the cylinder and the outer surface of the first section of the bumper and extending in an

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axial direction along the direction of the driving element, with the annular gap in contact with plural ports 43, that allows transfer of the air between the cylinder and the outside (see Figs. 1-3, C4, L6-9 and C6, L53-73). What Juilfs does not disclose is the use of a nailing tool. However, Golsch teaches that it is old and well known in the art to provide a nailing tool 10, a head portion, which holds cylinder 20, inner peripheral wall 22, with plural ports 80, end wall 24, with through hole 36, piston 26, with mounted driving element 32 and bumper 70 for the purpose of providing a nailing tool with a pneumatic return and to reduce shock (see figures 1,2 and C6, L58-68). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Juilfs with the nailing tool arrangement as taught by Golsch for the purpose of providing a nailing tool with a pneumatic return and to reduce shock.

In regard to claim 2, Golsch teaches that it is old and well known in the art of tool driving to provide a tool bumper 70, with an enlarged section 108, in contact with a recess 82 of the cylindrical wall 24 (see Figs. 2-4, 6 and C6, L22-34).

In regard to claim 3, Golsch teaches that it is old and well known in the art of tool driving to provide an inner wall 202, and connecting wall in the form of a recess 214 that secures the bumper in place (see Fig. 6 and C8, L36-49).

In regard to claim 4, While Juilfs discloses a driving tool that is powered pneumatically, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of providing a tool that can be powered by portable means. Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Juilfs by providing a tool

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powered by combustion for the purpose providing a tool that can be powered by portable means.

4. Claims 7,9,10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juilfs in view of Golsch and in further view of Kemper et al (US 4,050,505)

In regard to claims 7 and 15, Juilfs and Golsch disclose the invention substantially as claimed including a bumper comprised of a second section larger than the first and situated against the end wall. What Juilfs and Golsch do not disclose is the use of a composite bumper. However Kemper teaches that it is old and well known in the art to provide a two piece bumper that has an enlarged second section 9, that is less rigid than a first section 7, and abuts an end wall 13 and an inner wall for the purpose of reducing tool wear (see Figs. 1,2 and C2, L65 – C3, L7). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the tool of Juilfs and Golsch with the bumper elements as taught by Kemper for the purposes of reducing tool wear.

In regard to claim 9, While Juilfs discloses a driving tool that is powered pneumatically, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of providing a tool that can be powered by portable means. Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Juilfs by providing a tool powered by combustion for the purpose providing a tool that can be powered by portable means.

In regard to claim 10, Golsch teaches that it is old and well known in the art of tool driving to provide a tool with a head portion, which holds cylinder 20, inner peripheral wall 22, with plural ports 80 that communicate between the chamber and the outside for the purpose of providing a pneumatic reciprocation of the piston (see Fig.1 and C6, L5-11). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Juilfs by providing the head portion as taught by Golsch for the purpose of providing a pneumatic reciprocation of the piston.

5. Claims 11,13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juilfs in view of Golsch and in further view of Myers (US 4,558,584).

In regard to claim 11, Juilfs and Golsch disclose the invention substantially as claimed except for a second bumper section defining an annular gap. However, Myers teaches that it is old and well known in the art of reciprocating tools to provide a composite bumper comprised of sections 84 and 82, which define an annular gaps between the bumper sections and the cylinder wall for the purpose of reducing tool wear (see Fig. 2 and C3, L18-26). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the tool of Juilfs and Golsch with the bumper elements as taught by Myers for the purposes of reducing tool wear.

In regard to claim 13, While Juilfs discloses a driving tool that is powered pneumatically, the examiner takes Official Notice that it is old and well known in the art to provide a driving tool powered by combustion for the purpose of providing a tool that can be powered by portable means. Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Juilfs by providing a tool

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powered by combustion for the purpose providing a tool that can be powered by portable means.

In regard to claim 14, Golsch teaches that it is old and well known in the art of tool driving to provide a tool with a head portion, which holds cylinder 20, inner peripheral wall 22, with plural ports 80 that communicate between the chamber and the outside for the purpose of providing a pneumatic reciprocation of the piston (see Fig.1 and C6, L5-11). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Juilfs by providing the head portion as taught by Golsch for the purpose of providing a pneumatic reciprocation of the piston.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Juilfs in view of Golsch and in further view of Boothby et al (US 5,617,925).

Juilfs and Boothby disclose the invention substantially as claimed as applied to claim 1. What Juilfs and Boothby do not disclose is the use of a composite bumper. However, Boothby teaches that it is old and well known in the art of tool driving to provide plural bumper elements 102 and 104, with a different rigidity for the purpose of increasing tool life (see Fig. 5 and C9, L32-38). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the tool of Golsch with the bumper elements as taught by Boothby for the purposes of increasing tool life.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-5,7,9-11 and 13-16 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

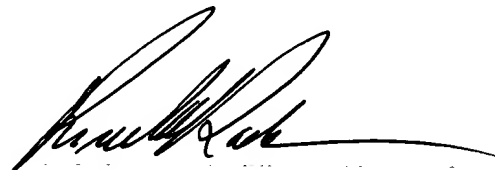
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jacobus, Volkman, Jordan, Rothfuss, Sobel, Perkins and Biddle et al have been cited to show devices having similar structure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand  
October 29, 2003



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700